

REMARKS

Claims 37-62 were pending in this application. No claims were added, amended, or cancelled. Hence, claims 37-62 remain pending in this application. A copy of the currently pending claims is provided in the Appendix for the convenience of the Examiner.

Claims 22-36 were previously cancelled in response to a Restriction Requirement dated August 30, 2002. Therefore, Applicant has changed their status identifiers from "Withdrawn" to "Cancelled" in order to reflect the cancelled status.

Claim Rejections Under 35 U.S.C. § 103(a)

Independent claims 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent Nos. 6,409,602 to Wiltshire et al. ("Wiltshire") and 6,580,710 to Paravia et al. ("Paravia"). The Examiner states that Wiltshire discloses each element of these claims except for the provision of personal identification information to the gaming sites via the remote terminal. The Examiner contends, however, that Paravia teaches this aspect of the invention, and that it would have been obvious to combine Wiltshire and Paravia to arrive at the claimed invention.

Claims 39-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wiltshire and U.S. Patent No. 6,001,016 to Walker ("Walker"). With respect to independent claims 39, 52, and 62, the Examiner states that Wiltshire discloses each element of these claims except for the collection of outcome data from the gaming machines located in the gaming establishment. The Examiner contends, nevertheless, that Walker teaches this aspect of the invention, and that it would have been obvious to combine Wiltshire and Walker to arrive at the claimed invention.

Applicant respectfully traverses these rejections on the basis that, even if there is motivation to combine the above references (which there is not), significant claim features and limitations are still missing from the proposed combinations.

Arguments in Support of the Claims

Applicant's invention, as recited in independent claims 37-39, 52, and 62, is directed to a remote gaming method, and a computer therefor, where players at gaming terminals located

outside a gaming establishment may play gaming machines located in the gaming establishment. As Applicant tried to explain in the previous response, the invention allows players to play a real gaming machine (i.e., not a virtual gaming machine) without having to be present at the gaming establishment. There are tremendous advantages to being able to play a real gaming machine without having to be present at the gaming establishment, including the benefits of reduced time, cost, and the overall convenience and comfort factor.

The Examiner contends that Wiltshire discloses each element of independent claims 37-39, 52, and 62 except for the aspects mentioned above, but that these aspects are obvious in light of Paravia and Walker. Applicant respectfully disagrees.

The most glaring defect in Wiltshire is the lack of a gaming site, as recited in the independent claims. The Examiner attempts to convert the “access website” 310 in FIG. 3 of Wiltshire into a gaming site. *Office Action, pages 2 and 4*. However, the access website 310 is merely a software download site for downloading the Wiltshire installation software. Once the software is installed, the website 310 contributes nothing else to Wiltshire (i.e., provides no gaming data or information to the client/terminal), as is abundantly clear from FIG. 3 and the accompanying text.

Indeed, Wiltshire actually distinguishes its system from website-based casino games in the Background section. For example, Wiltshire discusses the operation of non-website-based gaming stations versus casino gaming websites, concluding that existing non-website-based gaming stations are inferior because the gaming program is executed only on the individual gaming stations. *Col. 1, line 51 to col. 2, line 13*. (Wiltshire then explains in the Summary section that its gaming stations are an improvement because they use a gaming program that is executed on a server/host computer.) Thus, a person of ordinary skill in the art reading Wiltshire would have the perception that Wiltshire is actually distinguishable over website-based casino games.

Other differences between the claimed invention and Wiltshire include the use of **two separate intermediate nodes** – a gaming server and a gaming site – between the gaming machines and the remote gaming terminal. That is, the outcome data from the gaming machines passes through **two separate intermediate nodes** before arriving at the gaming terminal. Wiltshire fails to disclose any intermediate nodes, since the outcome data travels directly from

the host/server computer (which the Examiner compares to the claimed gaming machines) to the client/terminals. *See, e.g., Wiltshire's FIG. 1.*

In any event, there is a fundamental difference between Wiltshire and the claimed invention, namely, the use of actual gaming machines in the claimed invention versus a virtual gaming machine in Wiltshire. The Examiner glosses over this important distinction by saying that a host/server computer executing casino game programs is **functionally equivalent** to gaming machines in a gaming establishment. Applicant respectfully submits that the Examiner has failed to meet the criteria for raising such a functional equivalency rejection.

According to MPEP 2144.06, a functional equivalent must be recognized in the prior art and may not be based on the mere fact that the components are functional or mechanical equivalents:

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components. However, an applicant's expressed recognition of an art-recognized or obvious equivalent may be used to refute an argument that such equivalency does not exist.); *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) (Claims were drawn to a hollow fiberglass shaft for archery and a process for the production thereof where the shaft differed from the prior art in the use of a paper tube as the core of the shaft as compared with the light wood or hardened foamed resin core of the prior art. The Board found the claimed invention would have been obvious, reasoning that the prior art foam core is the functional and mechanical equivalent of the claimed paper core. The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another, and in this case, the use of a light wood or hardened foam resin core does not fairly suggest the use of a paper core.); *Smith v. Hayashi*, 209 USPQ 754 (Bd. of Pat. Inter. 1980) (The mere fact that phthalocyanine and selenium function as equivalent photoconductors in the claimed environment was not sufficient to establish that one would have been obvious over the other. However, there was evidence that both phthalocyanine and selenium were known photoconductors in the art of electrophotography. "This, in our view, presents strong evidence of obviousness in substituting one for the other in an electrophotographic environment as a photoconductor." 209 USPQ at 759.).

(MPEP 2144.06, emphasis added).

In the present case, nothing in Wiltshire suggests that a virtual gaming machine is functionally equivalent to an actual gaming machine in a gaming establishment. The Examiner has not produced any evidence from Wiltshire or any other art of record that a person of ordinary skill in the art recognizes a virtual gaming machine to be functionally equivalent to a gaming

machine in a gaming establishment. Without this evidence, Applicant respectfully submits there can be no basis for a rejection under functional equivalency.

Moreover, Applicant respectfully submits that the principle of functional equivalency is misapplied here. Functional equivalency is properly applied where two components are physical equivalents, either mechanically, chemically, or the like. *See MPEP 2144.06.* Otherwise, all simulations would be functional equivalents of their actual counterparts, and vice versa. For example, under the Examiner's assertion, a tank simulation/training system would be functionally equivalent to the operation of a real tank by the U.S. Army and, hence, not patentable. Wiltshire itself would be a functional equivalent of existing gaming machines and therefore not patentable.

Accordingly, based on the foregoing Wiltshire defects, even if there is motivation to combine Wiltshire with Paravia and/or Walker in the manner urged by the Examiner, the resulting combination would still not produce the claimed invention. Thus, withdrawal of the rejections against independent claims 37-39, 52, and 62 is respectfully requested.


As for dependent claims 40-51 and 53-61, although they may recite independently allowable subject matter, these claims depend from the independent claims and are therefore allowable for at least the same reasons. Accordingly, withdrawal of the rejections against the dependent claims is also respectfully requested.

CONCLUSION

In view of the above, Applicant believes each of the presently pending claims in this application is believed to be in immediate condition for allowance.

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Respectfully submitted,

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